

**REMARKS**

Claims 1-3, 5-10, and 12-14 are all the claims pending in the application.

***Claim Rejections - 35 U.S.C. § 112***

Claims 1 and 8 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. In particular, the Examiner asserts that “[t]he claims contain “performing modulation *on a tone representative of* the melody data”, which is not described in the specification” (Office Action, page 2, paragraph 3). For *at least* the following reasons, Applicants respectfully traverse the rejection.

As an initial matter, Applicants note that claim 8 does not recite the feature noted by the Examiner. Rather, claim 8 recites, *inter alia*,

- generating a tone for playing a melody in accordance with said melody data, by using said fetched tone information, wherein said tone is generated by performing a modulation processing on the tone based on said tone information contained in said melody data.

Moreover, the subject features in claims 1 and 8 are supported by *at least* page 7, lines 9-18 of the Specification. Further, in order to expedite prosecution, Applicants amend claims 1 and 8, which amendments are supported by *at least* the aforementioned portions of the Specification. Accordingly, Applicants respectfully submit that claims 1 and 8 comply with the requirements of 35 U.S.C. § 112.

***Claim Rejections – 35 U.S.C. § 103***

Claims 1-3, 5-10, and 12-14 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lin *et al.* (U.S. Patent No. 6,366,791, “Lin”) in view of Yoshino *et al.* (U.S.

Patent No. 6,308,086, “Yoshino”). For *at least* the following reasons, Applicants respectfully traverse the rejection.

Applicants respectfully submit that claim 1 is patentable over the alleged combination of Lin and Yoshino. For example, claim 1 relates to a mobile communication terminal equipped with an Internet browser function. The mobile communication terminal comprises, *inter alia*, means for fetching melody data from a web-based server apparatus by using said browser function, and tone setting means that generates ringing tones by using tone information contained in said melody data. The tone setting means generates the ringing tones by performing a modulation processing on the ringing tones based on said tone information contained in said melody data.

In the Office Action, it is acknowledged that Lin does not teach or suggest the claimed modulation processing. However, Yoshino’s col. 1, lines 54-63, col. 2, lines 46-49, col. 4, lines 32-40, and col. 5, lines 21-29 are relied upon for allegedly teaching this feature (Office Action, page 4, first full paragraph to second full paragraph).

Applicants respectfully submit that the Examiner is relying on impermissible hindsight in an effort to render the claimed tone setting means unpatentable. Absent Applicants’ own disclosure, there is no reason a skilled artisan would combine the teachings of Lin and Yoshino as proposed by the Examiner. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (MPEP § 2142). For instance, the Examiner asserts that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to further implement the communication terminal of Lin et al. so as to include modulation processing as per the teachings

of Yoshino so that the set ringing tones in the musical scores can be executed as ringing tone patterns on the MS” (Office Action, page 4, third full paragraph, emphasis added). Applicants respectfully disagree.

Lin, for example, already provides a technique for executing ringing tone patterns 65 associated with a musical score 55 on the mobile station (MS) 20. Specifically, Lin discloses that once the ringing tone pattern 65 is downloaded to the MS 20, the MS 20 is programmed for ringing according to the received ringing tone pattern 65 (Lin, col. 4, lines 25-29). Furthermore, in col. 2, lines 32-44, Lin discloses downloading ringing tone patterns associated with one or more musical score selection(s) of mobile subscribers associated with the MSs, and when the downloaded ringing tone pattern is executed, “the ringing tone pattern provides a musical ringing tone on the MS”. Therefore, the Examiner’s proposed reason for incorporating Yoshino’s teachings “so that the set ringing tones in the musical scores can be executed as ringing tone patterns on the MS” is inadequate since Lin already teaches a technique for executing the set ringing tones.

MPEP § 2141.III states that “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that ‘[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’” (emphasis added). Here, as noted above, there is

no adequate rationale provided in the Office Action that supports the Examiner's position that the combination of Lin and Yoshino is obvious.

Furthermore, the downloaded ring tone pattern 65 in Lin is ready to be executed on the MS 20 the instant it is downloaded, and thus, does not require any modulation thereto. In particular, Lin discloses that the ringing tone logic (RTL) 75 in the Home Location Register 26 (on the server-side) calculates a specific ring tone patterns 65 for a user-selected musical score 55 based on a model of the requesting MS 20 (*see* Yoshino, col. 4, line 39 to col. 5, line 2, and FIG. 4). Since the downloaded ring tone pattern 65 is already specific to the downloading MS 20, it is ready to be executed without any modulation once it is downloaded on the MS 20. As such, Applicants respectfully submit that a person of ordinary skill in the art, absent Applicants' own disclosure, would have no reason to draw from Yoshino to perform modulation processing on the downloaded ring tone pattern 65 in Lin.

Applicants note that MPEP 2145.X.A citing *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971) states that "[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper" (emphasis added). Since the Examiner has not provided an adequate basis for combining the teachings of Lin and Yoshino as pointed out above, a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of the improper 35 U.S.C. § 103(a) rejection.

Claim 8 recites generating a tone for playing a melody in accordance with said melody data, by using said fetched tone information, wherein said tone is generated by performing a modulation processing on the tone based on said tone information contained in said melody data. Therefore, claim 8 is patentable for *at least* reasons similar to those discussed above with respect to claim 1.

Claims 2, 3, 5-7, 9, 10, and 12-14 are patentable *at least* by virtue of their dependency.

### ***Conclusion***

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Quadeer A. Ahmed  
Registration No. 60,835

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: November 5, 2008